UNITED STATES PATENT AND TRADEMARK OFFICE

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1   UNITED STATES PATENT AND TRADEMARK OFFICE
2   _____
3
4   BEFORE THE BOARD OF PATENT APPEALS
5   AND INTERFERENCES
6   _____
7
8   *Ex parte* VINCENT FORMALE, MARKUS KOESTLER,
9   JAMIE RANDOLPH, GEETIKA SHINDE, ANDREE TAYLOR,
10   GERALD TIESKOETTER, and LAGRAY WELLS
11   _____
12
13   Appeal 2009-007225
14   Application 10/083,170
15   Technology Center 3600
16   _____
17
18   Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
19   BIBHU R. MOHANTY, *Administrative Patent Judges.*
20   FETTING, *Administrative Patent Judge.*

21   DECISION ON APPEAL[1]

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1 STATEMENT OF THE CASE[2]

2 Vincent Formale, et al. (Appellants) seek review under 35 U.S.C. § 134

3 (2002) of a final rejection of claims 1-30, the only claims pending in the

4 application on appeal. We have jurisdiction over the appeal pursuant to

5 35 U.S.C. § 6(b) (2002).

6 The Appellants invented an asset management system, based on an

7 automated web-based method, system, and Graphical User Interface (GUI)

8 for managing the inventory and disposition of property in a corporate or

9 other large-entity environment. (Specification 1:5-8).

10 An understanding of the invention can be derived from a reading of

11 exemplary claim 1, which is reproduced below [bracketed matter and some

12 paragraphing added].

13 1. A method of managing assets controlled by members of an
14 organization, said organization having a central server
15 configured to access data and software systems of said
16 organization, comprising the steps of:

17 [1] identifying one or more of said assets for management and
18 submitting an asset disposition request to said central server;

19 [2] at the central server,

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[2] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed June 23, 2008) and Reply Brief ("Reply Br.," filed November 18, 2008), and the Examiner's Answer ("Ans.," mailed September 18, 2008).

1   automatically,

2   based on receipt of said asset disposition request,

3   obtaining all required approvals for said asset disposition
4   request;

5   [3] at the central server,

6   automatically,

7   based on said obtaining of all required approvals,

8   effecting said asset disposition request; and

9   [4] at the central server,

10   automatically

11   modifying said data to reflect said effected disposition
12   request.

13

14   The Examiner relies upon the following prior art:

15 *Stanford University Property Administration Manual*, 7 Disposition 1,
16 http://www.stanford.edu/dept/UPA/chapter%207.html. (last visited Sept. 1,
17 2010)(hereinafter, Disposition).

18   Claims 2, 3, and 6-10 stand rejected under 35 U.S.C. § 101 as directed to

19 non-statutory subject matter.

20   Claims 11-20 stand rejected under 35 U.S.C. § 112, second paragraph, as

21 failing to particularly point out and distinctly claim the invention.

22   Claims 1-30 stand rejected under 35 U.S.C. § 102(b) as anticipated by

23 Disposition.

24   ISSUES

25   The issue as to statutory subject matter hinges on whether the dependent

26 claims incorporate the statutory subject matter of the parent claim. The issue

27 of indefiniteness hinges on whether the Specification and Drawings describe

1   structure that covers the functions in means plus function claims. The issue

2   of novelty hinges on what level of automation is recited in the claims and

3   whether the steps recited in the claims are performed as a central server in

4   the prior art.

5   FACTS PERTINENT TO THE ISSUES

6   The following enumerated Findings of Fact (FF) are believed to be

7   supported by a preponderance of the evidence.

8   *Facts Related to Appellants' Disclosure*

9   01.   Assets are identified for disposition by an operator manually

10   indicating that an asset is to be disposed of. Specification 7:19-

11   8:4.

12   02.   Approvals are indicated by approving officials' manually

13   entering approval on forms. Specification 9:14 -10:6.

14   03.   Effecting dispositions occurs as a result of human operators

15   entering information in a graphical user interface. Specification

16   10:7-12:9.

17   *Facts Related to the Prior Art - Disposition*

18   04.   Disposition is directed to procedures used at Stanford

19   University for disposing of fixed assets. Disposition 2: Overview.

20   05.   Disposition uses a software package, Capital Asset

21   Management System (CAMS) implemented on Oracle Fixed

22   Assets for disposing of fixed assets. Disposition 2: Overview.

23   Oracle is a database company.

1   06.   Disposition describes identifying assets for disposal, submitting

2   a disposition request, obtaining required approvals, effecting the

3   disposition request and updating the records accordingly.

4   Disposition 5:16 – 7:42 and Table on pp. 11-12.

5   ANALYSIS

6   *Claims 2, 3, and 6-10 rejected under 35 U.S.C. § 101 as directed to non-*

7   *statutory subject matter.*

8   Claim 1 is the sole independent claim. The Examiner has not rejected

9   claim 1. As the Appellants point out (Reply Br. 9), the claims rejected

10   incorporate the subject matter of claim 1. Thus, the Examiner erred in

11   rejecting the dependent claims when their parent claim recited statutory

12   subject matter.

13   *Claims 11-20 rejected under 35 U.S.C. § 112, second paragraph, as failing*

14   *to particularly point out and distinctly claim the invention.*

15   The only independent claim in this group, claim 11, includes means for

16   identifying assets and submitting a request, means for automatically

17   obtaining approvals, means for automatically effecting the request, and

18   means for automatically modifying data. The Examiner found that the

19   Specification failed to disclose structure covering the means recited in these

20   means plus function claims. Ans. 4. The Appellants contend that Fig. 11 in

21   the originally filed disclosure provides a flow chart that shows an

22   algorithmic structure covering these means. Reply Br. 10.

23   When a claim uses the term "means" to describe a limitation, a

24   presumption inheres that the inventor used the term to invoke 35 U.S.C. §

1   112, paragraph 6. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed.

2   Cir. 2003). "This presumption can be rebutted when the claim, in addition to

3   the functional language, recites structure sufficient to perform the claimed

4   function in its entirety." *Id.* Once a court concludes that a claim limitation is

5   a means-plus-function limitation, two steps of claim construction remain: 1)

6   the court must first identify the function of the limitation; and 2) the court

7   must then look to the specification and identify the corresponding structure

8   for that function. *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*,

9   344 F.3d 1205, 1210 (Fed. Cir. 2003).

10   "If there is no structure in the specification corresponding to the

11   means-plus-function limitation in the claims, the claim will be found invalid

12   as indefinite." *Biomedino, LLC v. Waters Technologies Corp.*, 490 F.3d 946,

13   950 (Fed. Cir. 2007); *see also In re Donaldson*, 16 F.3d 1189, 1195 (Fed.

14   Cir. 1994) (en banc).

15   In *Aristocrat Techs. Austl. Pty Ltd. v Inter. Game Tech.*, 521 F.3d 1328,

16   1333 (Fed. Cir. 2008), the court set forth that for a claim to a programmed

17   computer, a particular algorithm may be the corresponding structure under

18   § 112, sixth paragraph:

19   For a patentee to claim a means for
20   performing a particular function and then to
21   disclose only a general purpose computer as the
22   structure designed to perform that function
23   amounts to pure functional claiming. Because
24   general purpose computers can be programmed to
25   perform very different tasks in very different ways,
26   simply disclosing a computer as the structure
27   designated to perform a particular function does
28   not limit the scope of the claim to "the
29   corresponding structure, material, or acts" that

1   perform the function, as required by section 112
2   paragraph 6.

3   In two other recent cases, the Federal Circuit followed *Aristocrat* in

4   holding means-plus-function claims invalid for indefiniteness for lack of

5   sufficient description of algorithms to transform a general purpose computer

6   to a special purpose of computer under 35 U.S.C. § 112, sixth paragraph.

7   *See Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340-41 (Fed.

8   Cir. 2008) and *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1367

9   (Fed. Cir. 2008).

10   Thus the issue is whether the flow chart in Fig. 11 describes an

11   algorithmic structure for performing the recited functions. We find Fig. 11

12   does not. Fig. 11 is simply a series of boxes connected serially in which

13   each contains the name of a function. The sole support for the means for

14   identifying assets and submitting a request are blocks 1101 and 1107,

15   replicating those functions, without disclosing structure as to how those

16   functions are performed. Similarly only support for the means for

17   automatically obtaining approvals is blocks 1108 which says only "Form

18   Generated Approval Routing" with no structure as to how such routing

19   occurs. There are no blocks corresponding to means for automatically

20   effecting the request, and means for automatically modifying data.

21   Although Figure 11 is further described at Specification 12-14, this portion

22   only further elaborates on the function, such as exemplary sources of

23   approval, without describing physical or algorithmic structure for

24   implementing the functions. Thus, we find that there is no description of

25   structure covering the means for the functions recited in claim 11 and its

26   dependent claims.

1   *Claims 1-30 rejected under 35 U.S.C. § 102(b) as anticipated by*

2   *Disposition.*

3   The Examiner found that Disposition described all of the limitations in

4   the independent claims. Ans. 9. The Appellants contend Disposition

5   performs some functions manually and fails to show a central server that

6   automatically performs the recited functions.   Appeal Br. 6-10; Reply Br. 4-

7   8.

8   It is uncontested that Disposition describes the steps absent the modifier

9   "automatically." Indeed, Disposition lays out a procedure that includes

10   these steps. FF 06. Similarly it is uncontested that Disposition describes a

11   server, as an Oracle based database package is used to implement the

12   procedure and Oracle is known to produce database packages relying on

13   servers.   FF 05. The arguments are that more than one server is used; that

14   operations are performed at terminals in addition to the server; and that

15   much of Disposition is performed manually. Thus we come down to the

16   issue of claim construction.

17   As to the issue of whether a single server is used, we find that a server is

18   not necessarily constrained to one physical machine; it may be a singular

19   functional structure whose implementation is spread over several subservient

20   machines operating cooperatively, as in a database server that is spread over

21   multiple computers. While each computer may be labeled a server as well,

22   the composite forms a single server that serves client requests. The claim

23   makes no structural limitations on the server configuration. As to the issue

24   of performing tasks "automatically," although this term may mean absent

25   human intervention, some of the steps in the claim clearly require some

1   human intervention. Obtaining approval requires a human indicating

2   approval. FF 02. Effecting disposition requires human indication of which

3   manner of disposition (FF 03) and physical transference. Therefore, the

4   word "automatically" must mean with the aid of automation rather than

5   without human intervention. Clearly all of the steps performed by

6   Stanford's disposition procedure are done with the aid of CAMS. FF 04.

7   None of the steps specify which portions of how each step is implemented

8   are done automatically.

9   CONCLUSIONS OF LAW

10   Rejecting claims 2, 3, and 6-10 under 35 U.S.C. § 101 as directed to

11   non-statutory subject matter is in error.

12   Rejecting claims 11-20 under 35 U.S.C. § 112, second paragraph, as

13   failing to particularly point out and distinctly claim the invention is not in

14   error.

15   Rejecting claims 1-30 under 35 U.S.C. § 102(b) as anticipated by

16   Disposition is not in error.

17   DECISION

18   To summarize, our decision is as follows.

19   •   The rejection of claims 2, 3, and 6-10 under 35 U.S.C. § 101 as

20   directed to non-statutory subject matter is not sustained.

21   •   The rejection of claims 11-20 under 35 U.S.C. § 112, second

22   paragraph, as failing to particularly point out and distinctly claim the

23   invention is sustained.

1   •   The rejection of claims 1-30 under 35 U.S.C. § 102(b) as anticipated

2   by Disposition is sustained.

3   No time period for taking any subsequent action in connection with this

4 appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.

5 § 1.136(a)(1)(iv) (2007).

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7   <u>AFFIRMED</u>

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